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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,415	05/10/2001	Victor Y. Tsao	22561-703	7670

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EXAMINER

TESLOVICH, TAMARA

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/854,415

Applicant(s)

TSAO ET AL.

Examiner

Tamara Teslovich

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05/10/01.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-48 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 1-20, 21-38 and 48, drawn to a system for secure data transaction between a remote device and a host device, classified in class 713, subclass 168.
- II. Claim 39, drawn to a method of enrolling a remote device with a host device, classified in class 713, subclass 184.
- III. Claim 40, drawn to a method for verifying the enrollment of a remote device with a host device, classified in class 713, subclass 170.
- IV. Claims 41-42, drawn to a method of transferring data between a previously enrolled remote device with a host device, classified in class 713, subclass 179.
- V. Claims 43-47, drawn to a secure system for user enrollment and verification through the combined usage of voice and character pins, classified in class 713, subclass 186.

Reasons for the combination of claims in Invention I:

It appears to the examiner that the dongle enrollment and verification system of claim 48 incorporates the secure transaction dongle of claims 21-38. It

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also appears that the secure transaction system of claims 1-20 is a broader version of the secure transaction dongle of claims 21-38. For purposes of simplicity and clarity, the examiner will use claim 48 as a representative of Invention I when necessary.

Inventions I and II are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, Claim 48 as claimed does not require the particulars of Claim 39 to function. Because the combination as claimed in claim 48 does not set forth details of the subcombination, such as the first and second level encryptions and use of public keys, the inventions are distinct. The subcombination has separate utility such as an electronic voting booth.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Examination of Invention I would rely on prior art included within class 713, subclass 168 to deal with multiple computer communications using cryptography while examination of Invention II would focus on art classified in class 713, subclass 184 in order to search prior art systems involving system access control based on user identification by cryptography using PIN/password generators.

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A complete response to this requirement must include an election of the invention to be examined, even if the requirement is traversed.

Inventions I and III are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the method of controlling and managing data communication between a remote device and a host device as claimed in Invention I does not require the particulars of the subcombination as claimed and because the combination as claimed in Invention I does not set forth any of the details of the subcombination as separately claimed in Invention III, the inventions are distinct. The subcombination has separate utility such as the verification of users on a computer network.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Examination of Invention I would rely on prior art included within class 713, subclass 168 to deal with multiple computer communications using cryptography while examination of Invention III would focus on art classified in class 713, subclass 170 in order to search prior art systems involving the authentication of entities in multiple computer communication using cryptography. A complete

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response to this requirement must include an election of the invention to be examined, even if the requirement is traversed.

Inventions I and IV are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed in Invention I does not require the particulars of the subcombination of Invention IV, such as updating previously stored encrypted ID numbers. The subcombination has separate utility such as a dynamic local computer network.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Examination of Invention I would rely on prior art included within class 713, subclass 168 to deal with multiple computer communications using cryptography while examination of Invention IV would focus on art classified in class 713, subclass 179 in order to search prior art systems involving the transfer of data between previously enrolled entities already on record. A complete response to this requirement must include an election of the invention to be examined, even if the requirement is traversed.

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Inventions I and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, Invention V has separate utility such as a home security system. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Examination of Invention I would rely on prior art included within class 713, subclass 168 to deal with multiple computer communications using cryptography while examination of Invention V would focus on art classified in class 713, subclass 186 in order to search prior art systems involving verification through biometric acquisition in access-controlled systems. A complete response to this requirement must include an election of the invention to be examined, even if the requirement is traversed.

Conclusion

A shortened statutory period for response to this action is set to expire one month (not less than 30 days) from the mail date of this letter. Failure to respond within the period for response will result in ABANDONMENT of the application (see 35 U.S.C. 133, MPEP 710.02, 710.02(b)).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara Teslovich whose telephone number is (571) 272-4241. The examiner can normally be reached on Mon-Fri 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Andrew Caldwell
Andrew Caldwell